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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY BOOKING NO.
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EXAMINER GALLAGHER, J
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ART UNIT 1233	PAPER NUMBER
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01/05/99

DATE MAILED:

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.

Applicant(s)

Examiner

Group Art Unit

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

## Status

- ☒ Responsive to communication(s) filed on 17 SEPTEMBER 1998
- ☒ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 1 1; 453 O.G. 213.

## Disposition of Claims

- ☒ Claim(s) 1 - 39 is/are pending in the application.
- Of the above claim(s) 1 - 26 is/are withdrawn from consideration.
- ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- ☒ Claim(s) 27 - 39 is/are rejected.
- ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- ☒ Claim(s) 1 - 39 are subject to restriction or election requirement.

## Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
  - ☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been received.
  - ☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.
  - ☐ received in this national stage application from the International Bureau (PCT Rule 1 7.2(a)).

\*Certified copies not received: \_\_\_\_\_

## Attachment(s)

- ☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 3
- ☐ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Interview Summary, PTO-413
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Other \_\_\_\_\_

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1.

The restriction requirement imposed in the last Office action is deemed proper for the reasons set forth therein; and is therefore hereby reiterated and made FINAL.

Claims 1-26 stand withdrawn from further consideration by the Examiner as being directed to a non-elected invention; 37 CFR 1.142(b).

Election is made WITHOUT traverse in Paper #5.

2.

The disclosure is objected to because of the following informalities: (a) the amendments to the specification proposed at page 2, lines 4-5, 8-9 and 14 (with respect to diethoxyethane) of the amendment could not be located and were therefore NOT entered; (b) page 3, line 13- delete "and" (see paragraph 7, line 6 of the last Office action); and (c ) what is intended by the (unfamiliar) term "butyrate" (at page 3, line 5)/"butyrate resin" (claim 28) is still not understood i.e. what is this material (composed of) chemically?.

Appropriate correction is required.

3.

Claims 28-29 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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Specifically (a) note that the dependency numeral in line 1 of claim 28 should be "27" and NOT "29" as presented, and that claim 29 depends from itself; and (b) further regarding claim 28 at line 2, see paragraph 2(c) above.

4.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5.

Claims 27-29, 31-36 and 38-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over any one of the prior art admission or King or Meyers, <sup>EACH</sup> ~~and~~ in view of Masuzaki et al.

6.

Claim 30, 32 and 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over any one of the prior art admission or King or Meyers, each in view of Masuzaki et al and Smrt et al.

7.

Applicant's arguments filed 17 September 1998, to include the declaration submitted under 37 CFR 1.132, have been fully considered but they are not persuasive.

The foregoing art rejections are adhered to essentially for the reasons of record (see paragraphs 13-14 of the last Office action); further, with each of these rejections, it is the sum

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total of the teachings of the applied, combined references taken as a whole which is held/seen to render applicants invention obvious to one of ordinary skill in this art (In re McLaughlin 170 USPQ 209), and therefore applicants piecemeal attack on the references individually cannot establish unobviousness, since these rejections are based upon a combination of references (In re Mapelsden 141 USPQ 30) i.e. these rejections are not overcome by pointing out that one reference does not contain a particular teaching when the reliance for that teaching was on another reference (In re Lyons 150 USPQ 741), with the following being additionally advanced:

(a) contrary to applicants contentions, sufficient suggestion/motivation/direction to one of ordinary skill in this art is held/seen to indeed be present in the applied references themselves (all of which are held/seen to be sufficiently analogous/reasonably pertinent to each other) to enable their proper and tenable combination as set forth in the art rejection statements of record; further along this line (1) note that Masuzaki et al are not apparently limited with respect to the substrate materials which may be adhered using their adhesive; further, these patentees fairly/clearly disclose (N.B. column 1, lines 17-18, column 3, lines 12-16) that their aerosol adhesive is preferable (i.e. impliedly superior) to their adhesive/ composition applied by coating WITHOUT using a propellant<sup>a</sup>, in the same manner as disclosed by applicant; (2) it is axiomatic that the test for obviousness under 35 USC 103 is NOT whether the proposed reference combination is expressly suggested in ANY of the references, the proper test being rather what the combined teachings of the references, as a whole, would suggest to the art-skilled (Leinoff v. Milona 220 USPQ 845; In re Keller 208 USPQ 871); and (3) applicants reliance on the difference in the dates

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of the applied references of record to impart unobviousness to the claims is held/seen to be misplaced/unconvincing, in that the question to be addressed regarding unobviousness is whether the combination of references proposed by the Examiner would have been obvious to one of ordinary skill in the relevant art at the time the claimed invention was made, irrespective of the dates of the applied references; (b) nothing was attributed to the prior art admission that was not disclosed in the specification; and (c) the declaration has been given what is felt to be a careful consideration, but is deemed insufficient to overcome the art rejections of record, for the following reasons (1) it is apparently not a comparison with the best prior art cited/applied by the Examiner, as proposed/espoused in *In re Caveney* 155 USPQ 681; (2) while the results set forth therein may be superior, they are held/seen not to be unexpected, but rather to derive from/be inherent in the aerosol <sup>o</sup>made of adhesive application (again, the PREFERRED technique of Masuzaki et al), which <sup>o</sup>made apparently eliminates/overcomes the problems as disclosed/discussed at page 1, lines 24-27 of applicants specification; further, (such) superior results do not necessarily preclude a finding of obviousness even when not precisely forecast by the relevant art, the statutory mandate being for an evaluation of the invention as a whole (*In re Lindell* 155 USPQ 521); and (3) perhaps most importantly, the QUIKWELD formulation/product discussed/referred to at pages 7-8 apparently constitutes applicants inventive composition, such that it is unclear whether there are any public use and/or on <sup>a</sup>sole statutory bar problems involved with this material. In ~~the~~ conclusion, the evidence against patentability is held/seen to outweigh that for patentability i.e. the gap (if any) between the envisioned, claimed

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invention and the teachings of the applied, combined references of record is held/seen to be simply not so great as to render the invention unobvious to one reasonably skilled in this art, any differences which might possibly/conceivably exist between this invention and these reference teachings being held/seen NOT to constitute patentable differences.

8.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

9.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to J.J. Gallagher whose telephone number is (703) 308-1971. The examiner can normally be reached on Monday-Friday from 8:30 AM to 5:00 PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Ball, can be reached on (703) 308-2058. The fax phone number for the organization where this application or proceeding is assigned is (703) 305-7115.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661/0662.

JTG  
J. Gallagher:jp  
1-2-99  
December 22, 1998



JOHN J. GALLAGHER  
PRIMARY EXAMINER  
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